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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,444	04/14/2005	Domenico Stigliani	P70537US0	6192
136 7590 10/16/2008 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004				
EXAMINER HENNING, MATTHEW T				
ART UNIT 2431		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,444

Applicant(s)

STIGLIANI ET AL.

Examiner

MATTHEW T. HENNING

Art Unit

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-893)
Paper No(s)/Mail Date 7/18/2005
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

This action is in response to the communication filed on 4/14/2005.

DETAILED ACTION

Claims 1-14 have been examined.

Title

The title of the invention is acceptable.

Information Disclosure Statement

The information disclosure statement(s) (IDS) submitted on 7/18/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

Drawings

The drawings filed on 4/14/2005 are acceptable for examination proceedings.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Appropriate correction is required.

Claim Objections

For the applicant's future reference: A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Claims 1-14 are objected to because of the following informalities:

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Below is a list of examples of grammatical issues found in the claims. This list is not exhaustive and as such the applicant should carefully review the claims, removing all grammatical and idiomatic errors from the claims.

Claims 1-14 recite "Method for", "System for", and "Device for". The claims should recite "A method for", "A system for", "A device for", "The method for" etc.

Claims 1, 4, 5, 6, 8, and 9 recite "a coding", "a decoding", "the decoding", or "the coding". The examiner notes that this is not grammatically correct, as "coding" and "decoding" are not nouns, they are verbs, and as such should be used in the proper grammatical manner.

Claim 1 recites "verifying and signaling the fact of having or not having received a message previously with the same univocal message identifier associated," which is awkwardly worded.

Claim 7 recites "in which **encryption and decryption** are the type with public/private key", which lacks antecedent basis in the claim. The examiner will assume for the purposes of searching prior art, that claim 7 was meant to depend from claim 6 instead of claim 3.

Claim 8 recites "the checking username" which lacks antecedent basis in the claim. The examiner will assume for the purposes of searching prior art that this limitation was meant to read "the checking identifier".

Claim 9 recites "the message identifier" which lacks antecedent basis in the claim. The examiner will assume for the purposes of searching prior art that this limitation was meant to read "the message username".

Claim 10 recites "system in accordance with claim 8", while claim 8 is a method claim. The examiner will assume for the purposes of searching prior art, that claim 10 was meant to depend from claim 9 instead of claim 8.

Claim 11 recites "in that the **encryption and decryption** devices are the public/private key type", which lacks antecedent basis in the claim. The examiner will assume for the purposes of searching prior art, that claim 11 was meant to depend from claim 10 instead of claim 9.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a "system", a "method", and a "device". Appellant's specification, page 10, lines 6-8, provides intrinsic evidence through examples that Appellant intends for such system, method, and device to include embodiments which are "totally software, totally hardware or mixed." In the event that the claims are intended to be limited to a combination of hardware and software, or totally hardware, it is believed that the claims in question would be directed to patent-eligible subject matter (statutory). However, no such evidence that the embodiment covered by the claims in question is limited to inclusion of such hardware elements exists. Absent recitation of the hardware, the claims appear devoid of any physical articles or objects which may cooperate to achieve some function, and as such are not directed to a machine. Likewise, absent any such physical article or object, they cannot be directed to a manufacture. They are clearly not a composition of matter. Therefore, the claims in question do not appear to fall within a statutory category of invention as set forth in 35 USC 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Vincent (US Patent Application Publication 2003/0069967).

Regarding claim 1, Vincent disclosed a method for security verification of a message (Vincent Paragraph 0045 request message) transmitted and received in electronic form which: on the transmitting side comprises the steps of associating with the message for its subsequent security verification a univocal message identifier (unique nonce) and an identifier (Vincent Paragraph 0045 Signed partial response) for checking the identity of the message owner with the checking identifier being obtained by applying to the univocal message identifier a coding associated with the owner of the message to be transmitted (Vincent Paragraph 0045), and on the receiving side for security verification of a received message (Vincent Paragraph 0046) comprises the steps of: verifying and signaling the fact of having or not having received a message previously with the same univocal message identifier associated (Vincent Paragraph

0046 Lines 4-19), applying a decoding associated with a supposed owner of the received message to the checking identifier of the owner associated with the received message (Vincent Paragraph 0046 Lines 19-24), and ascertaining and signaling the agreement or not between the univocal message identifier associated with the received message and the result of said decoding of the checking username (Vincent Paragraph 0046 Lines 19-31).

Regarding claim 9, Vincent disclosed a system for a safety verification of a message transmitted and received in electronic form and comprising: on the transmitting side: a univocal message username generator (Vincent Paragraph 0045 generates a unique nonce value), an encoding device which receives the message username produced by the generator and codifies it in accordance with a code associated with the owner of the message to be transmitted to obtain therefrom an identifier for checking the identity of the message owner (Vincent Paragraph 0045 Signing the nonce with the private key), transmission means which associate with the message to be transmitted the checking identifier and the univocal message identifier obtained (Vincent Paragraph 0045), on the receiving side for security verification of a received message: a control device which verifies and signals that the message identifier associated with the received message has or has not been received previously (Vincent Paragraph 0046 Lines 4-19), a decoding device which receives the owner checking identifier associated with the received message and applies thereto a decoding associated with a supposed owner of the received message (Vincent Paragraph 0046 Lines 19-24), verification means which ascertain and signal the agreement or not of the univocal message identifier with the result of the decoding of the checking username (Vincent Paragraph 0046 Lines 19-31).

Regarding claim 12, Vincent disclosed a device for association of security verification factors with a message transmitted in electronic form characterized in that it comprises: a univocal message username generator (Vincent Paragraph 0045 generates a unique nonce value), an encoding device which receives the message username produced by the generator and encodes it in accordance with a code associated with the owner of the message to be transmitted to obtain therefrom an identifier for checking the identity of the message owner (Vincent Paragraph 0045 Signing the nonce with the private key), means which associate with the message to be transmitted the checking identifier and the univocal message identifier obtained (Vincent Paragraph 0045).

Regarding claims 2 and 14, Vincent disclosed that before transmission the univocal message identifier and the identifier for checking the identity of the message owner are assembled in a unique compound identifier (Vincent Paragraph 0045).

Regarding claim 3, Vincent disclosed that on the transmitting side at least the checking identifier is assembled with the message and transmitted therewith (Vincent Paragraph 0045).

Regarding claim 4, Vincent disclosed that the assembling takes place by inserting the message identifier in the message and applying the coding to the result of the insertion (Vincent Paragraph 0045).

Regarding claim 5, Vincent disclosed that on the transmitting side, with the message to be transmitted is also associated an owner identifier (Vincent Paragraph 0045 private key) and on the receiving side the decoding to be applied is selected from among a plurality of possible decodings on the basis of the owner identifier associated with the received message (Vincent Paragraph 0046 Lines 19-24).

Regarding claims 6, 10, and 13, Vincent disclosed that the coding and decoding are keyed encryption and decryption operations (Vincent paragraphs 0045-0046).

Regarding claims 7 and 11, Vincent disclosed that the encryption and decryption are the type with public/private key (Vincent Paragraphs 0045-0046).

Regarding claim 8, Vincent disclosed that ascertainment of the agreement between univocal message identifier associated with the message received and the result of the decoding of the checking username consists of verifying the sameness between said univocal message identifier and the result of the decoding of the checking username (Vincent Paragraph 0044).

Conclusion

Claims 1-14 have been rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW T. HENNING whose telephone number is (571)272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew T Henning/
Examiner, Art Unit 2431